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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,043	10/19/2001	Charles N. Serhan	7214.07	5334

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EXAMINER

JONES, DWAYNE C

ART UNIT PAPER NUMBER

1614

DATE MAILED: 10/22/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicant N .

10/042,043

Applicant(s)

SERHAN, CHARLES N.

Examiner

Dwayne C Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 August 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 20-22, 26-28, 30 and 32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-22, 26-28, 30 and 32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Claims***

1. Claims 20-22, 26-28, 30, and 32 are pending.
2. Claims 20-22, 26-28, 30, and 32 are rejected.
3. Claims 1-19, 23-26, 29, and 31 are cancelled.

### ***Response to Arguments***

4. Applicant's arguments with respect to claims 30 and 32 have been considered but are moot in view of the new ground(s) of rejection. In addition, it is unclear from the amendment of August 25, 2003 whether or not claim 26 is cancelled or amended. Clarification of this anomaly is requested.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 30 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olson et al. in view of Takano et al. Olson et al. teach of the importance of the phospholipase D in the signaling cascade leading to neutrophil activation. In fact, the prior art reference of Olson et al. teaches of regulation of the receptor-regulated phospholipase D in human neutrophils, (pages 3 and 4, under the section entitled

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Introduction). Takano et al. disclose that the activation of neutrophil (PMN) is critical in inflammation, which suggests of PMN-directed therapies for clinical use, (see abstract). Takano et al. also teach that lipoxins, such as lipoxin A<sub>4</sub> and aspirin-triggered 15-epi-lipoxin A<sub>4</sub>, inhibit human PMN response. This shows that the actions of lipoxin analogs inhibited PMN infiltration in inflammation studies, (see page 819, column 2, paragraph 2). Moreover, the fact that the PMN inflammation is associated with TNF alpha is embraced by the above-stated teachings, in particular Takano et al. because it is well established in the art that cytokines, namely TNF alpha, trigger an inflammatory response, (see Lloyd et al.). In fact, Takano et al. specifically list examples of lipoxin compounds in Figure 2 on page 821. Accordingly, the skilled artisan would have been motivated to utilize the lipoxin analogs of Takano et al. to treat inflammatory diseases associated with TNF alpha since the prior art teaches that there is a connection between neutrophil activation, inflammation and the cytokine of TNF alpha, and consequently a therapy for treating diseases associated with TNF alpha.

7. Moreover, these two claims are pharmaceutical compound claims that are combined with an intended use in the form of instructions of using these compounds. For these reasons, In addition, the printed matter on a label or package insert of a kit or container does not lend patentable weight as a limitation of the claimed product, composition, or article of manufacture, absent a functional relationship between the label or package insert of a kit and the product, composition, or article of manufacture of a kit or container.

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8. See *In re Haller* 73 USPQ 403 (CCPA 1947), where it is held that application of printed matter to old article cannot render the article patentable. In the opinion text of *In re Haller*, it is stated that: Whether the statement of intended use appears merely in the claim or in label on the product is immaterial so far as the question of Patentability is concerned. . . In accordance with the patent statutes, an article or composition of matter, in order to be patentable, must not only be useful and involve invention, but must also be new. If there is no novelty in an article or composition itself, then a patent cannot be properly granted on the article or composition, regardless of the use for which it is intended. The difficulty is not that there can never be invention in discovering a new process involving the use of an old article, but that the statutes make no provision for patenting of an article or composition which is not, in and of itself, new.

9. Also see *In re Venezia* 189 USPQ 49 (CCPA 1976), where kits are drawn to the structural attributes of interrelated component parts and not to activities that may or may not occur. Further, *In re Miller* 164 USPQ 46 (CCPA 1969) and *In re Gulak* (CAFC) 217 USPQ 401 relate to a mathematical device and to a measuring cup respectively. In each of these cases, the printed matter is considered a patentable distinction because the function of the device depends upon the printed matter itself, which is a patentable distinction because the function of the device depends upon the printed matter itself, which is a part of the substrate; without the printed indicia or numbers, the substrates lose their function. Such is not the case with the instantly claimed articles or kits. The claimed articles of the kit remain fully functional absent the labeling or printed instructions for use.

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10. Thus the instructions for use included in a kit or article manufacture constitute an "intended use" for that kit or article of manufacture. Intended use does not impart patentable weight to a product. See MPEP 2111.03: Intended use recitations and other types of functional language cannot be entirely disregarded. However, in apparatus, article and composition claims, intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963).

11. In the instant case, the kit claims are drawn to an old article or composition, which further comprises labeling instructions. The intended use, which is recited on the label or package of the insert, lacks a function relationship because the insert or label does not physically or chemically affect the chemical nature within the article of manufacture, and furthermore, the old article or old composition of the kit can still be used by the skilled artisan for other purposes. Therefore the old article or composition which are comprised with the claimed kit are unpatentable over the prior art, because they function equally effectively with or without the labeling, and accordingly no functional relationship exists between the instructions for use and the composition.

12. Thus the claims are addressed as being drawn to an article of manufacture comprising an old composition of a kit and a package insert, the instructions on the

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insert bearing no patentable weight with regard to double patenting, 102 and 103 rejections.

### ***Obviousness-type Double Patenting***

13. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. Claims 20-22, 26-28, 30, and 32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S.

Patent No. 6,353,026. Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. Patent No. 6,353,026 also teaches of lipoxin analogs where the substituents of Q<sub>4</sub>H and Q<sub>3</sub>H are also hydroxyl groups and embrace all types of stereochemical orientations of these substituents of Q<sub>4</sub>H and Q<sub>3</sub>H.

15. The rejection of claims 20-22, 26-28, 30, and 32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 20-28, 30, and 32 of copending Application No. 10/004,155 is also maintained and repeated. Although the conflicting claims are not identical, they are not patentably distinct from each other because copending Application No. 10/004,155

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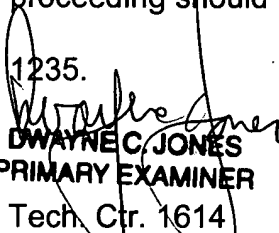
teaches of a generic lipoxin group of compounds. The instant claims differ from copending Application No. 10/004,155 by reciting a specific species and a more limited genus than copending Application No. 10/004,155. However, it would have been obvious to one having ordinary skill in the art to select any of the species of the genus as taught by copending Application No. 10/004,155, including those instantly claimed, because an ordinary artisan would have the reasonable expectation that any of the species of the genus would have similar properties and, thus, the same use as the genus as a whole.

16. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. C. Jones whose telephone number is (703) 308-4634. The examiner can normally be reached on Mondays through Fridays from 8:30 am to 6:00 pm. The examiner can also be reached on alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel can be reached on (703) 308-4725. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

  
DWAYNE C. JONES  
PRIMARY EXAMINER

Tech. Ctr. 1614  
October 21, 2003